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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,812	10/18/2001	Scott A. Boyd	4164-170	1775

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EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/035,812

Applicant(s)

BOYD ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of claims 1-9 in the paper received 18 February 2004 is acknowledged.

Claims 10-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. As iterated above, election was made **without** traverse.

### *Claim Rejections - 35 USC § 112*

The rejection of claim 13 under 35 USC § 112 first paragraph has been withdrawn due to the fact that the claim is withdrawn as not being elected.

The rejection of claims 1-9 under 35 USC § 112 second paragraph has been hereby withdrawn due to the amendment filed 18 February 2004 correcting the noted deficiencies.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and those dependent therefrom are indefinite in that one of ordinary skill in the art would not understand the process flow, as it appears to be contradictory within itself. Step (c) iterates that the player places a wager and then a space is chosen until all of the spaces associated with one of the subsets are selected in some order. However, step (d) states that a bonus is awarded when the spaces form a completed subset. This seems to contradict the process of step (c) which continues until the spaces are completely selected. One of ordinary

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skill in the art would not understand what is intended of step (c) as it appears that every time a user plays they will end up winning. This contradicts that which is claimed at step (d), which states a prize is awarded when the spaces are completed. This process is indefinite to a skilled artisan as it appears that the method would always continue until a win; however, contradictorily it only awards upon a win. It is not clear how this is possible that the method repeats until a win yet at the same time only awards at a win. As currently claimed, the method would always also eventually end in a winning outcome which also seem contradictory as to how gaming pay tables are generated and balanced. Thus, a skilled artisan would not understand how to properly apply the method, seemingly contradictory, to a gaming machine, and thus it is indefinite.

For examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 5-7 and 9, as best understood, are under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935).

Odom discloses a method of implementing a game on an electronic gaming machine wherein a player places a wager (Column 3, lines 6-8). The spaces of Odom are organized into and associated with one or more subsets wherein each space is in a predetermined order within its associated subset. Each space is predetermined to be above a certain other space in a specific order to form a grid, in the exemplary embodiment, the grid ordering the spaces respectively into a 5 x 5 array. In response to the wager and under control of the machine, the processor controls the selection of a first outcome (Column 4, lines 12-15) which is one of the

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plurality of spaces. The selection is in relation to a plurality of spaces organized into a subset with each space corresponding to a particular subset (FIG 1). The subsets run horizontal, vertical, diagonal, and are based on suitable patterns for the play of bingo (Column 4, lines 24-30).

This BINGO game is continued until all of the numbers have been called at which point the spaces are compared and a bonus prize is awarded if a subset has been completed (Column 4, lines 24-40). Odom does not disclose that the process is required to be repeated until a win but it is within the scope of Odom that if the player does not win, the player may choose to place another wager until the spaces of one of the subsets becomes filled at which time a prize will be awarded, thus Odom is capable of generating a revenue while continuing to allow the player to pay for further selections.

Regarding claim 2, the spaces are organized into a BINGO card with the order of B then I then N then G then O (FIG 1). This order is predetermined via the characteristics associated with the matrix itself.

Regarding claim 5, Odom discloses a number of subsets that can be used to achieve a pattern, thus including horizontal, diagonal, coverall, etc. (Column 4, lines 10-40). Thus, some of the spaces correspond to more than one of the subsets. Odom also discloses a coverall as a subset thus using a subset that is a plurality of other subsets of spaces (the rows, or columns per se) and in this case the spaces are also associated with more than one of the plurality of possible subsets.

Regarding claim 6, a bonus prize is awarded for the completion of more than one of the subsets (Table A, Cover All) thus including a plurality of subsets.

Regarding claim 7, this bonus is special for the simultaneous completion of all subsets, thus representing what is known in the art as a coverall (Table A).

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Regarding claim 9, Odom does not explicitly disclose the bonus script; however, it is notoriously well known in the art that the software is used to strictly control the bonusing and awards of the gaming machine and it would be known that a script would be used to make sure that the bonusing and awards perform as desired and within the acceptable range for a gaming commission.

Claims 3 and 4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935) in view of Yoseloff (US Patent No. 6,398,645).

Odom does teach associating a prize with a bingo achieved on the card. However, Odom does not disclose the use of more than one bingo card.

Yoseloff discloses such a feature in a slot machine game. Yoseloff discloses a variant of Bingo in which the player is provided a multiple number of Bingo Cards on the video screen (Abstract). By allowing the player a number of cards, the player feels like they have a better chance of winning. It would therefore be obvious to one of ordinary skill in the art to allow for a multiple number of gaming cards to be displayed in the Odom device as disclosed by Yoseloff. One of ordinary skill in the art would be motivated to make this incorporation in order to provide the player with a greater number of chances in the bonus round, thus enhancing the excitement of the game for the player and giving the player the impression of having a better chance of winning based on the greater number of cards available in the bonus round.

Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935) in view of Adams (US 2002/0045472).

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Odom discloses the player receives a special bonus prize for using maximum bet but Odom does not disclose that bingo can only be called when a maximum bet is received. However, it is notoriously well known in the art, that prizes in games are often only available to a user who placed the maximum bet.

Adams teaches such a concept in disclosing a bingo game for use in a slot machine. The machine can detect if a maximum wager was placed (paragraph 6). Upon detection, a random one of the spaces are chosen (paragraph 6). It would be obvious to one of ordinary skill in the art to allow for the device of Odom to only reward the bonus prize upon the use of a maximum wager, as such a factor is disclosed by Adams and notoriously well known in the art. One of ordinary skill in the art would be motivated to make this incorporation in order to control the return on the machine and encourage the player to use maximum wagering thus increasing the income for the casino.

### ***Response to Arguments***

Regarding the Applicant's argument that Odom does not teach selection elements having a particular predetermined order, the Examiner respectfully disagrees. The spaces of Odom have a predetermined order that is associated with their positioning on the screen. Each space has a predetermined order in the presented matrix. The Applicant's arguments regarding previous spaces needing to be selected in order for subsequent spaces to be selected, the Examiner contends that such language is not coterminous with what is actually being claimed. The actual claim language only requires selection in a consecutive or non-consecutive order, there is no mention of the requirements being argued by the Applicant.

Regarding the Applicant's argument that Odom does not teach a sequential order in a bonus game, the Examiner respectfully identifies that there is no claim language that matches the merits of this argument. The language states that a bonus prize is awarded when the

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spaces are selected to form a completed set. Sequential order does not appear to actually be claimed when requiring the spaces to be selected, just a consecutive or non-consecutive order, which is accomplished by Odom as discussed above.

Regarding Applicant's argument that the visual representation of B-I-N-G-O does not corresponded to an order, the examiner respectfully disagrees. Each space has a specific order and place in the matrix that is predetermined. The game would not work correctly if the pieces were not in their required order. Further, Applicant's argument that Odom's order is not that of only allowing a piece to be obtained if previous spaces in order are obtained, the Examiner maintains that such language is not conducive to the claim language, which only requires selecting a random space in consecutive or non-consecutive order which as defined above is accomplished in Odom.

Regarding Applicant's argument that Odom spaces are not organized into subsets except after the fact, the Examiner respectfully disagrees and notes that the spaces are organized at the beginning of the game and presented to the player in this order before selection begins.

Regarding Applicant's assertion that Odom is not dependent on consecutive or non-consecutive order, the Examiner respectfully disagrees. The spaces of Odom are selected based on a selection of a space by the processor and this order is in a non-consecutive order.

Regarding Applicant's assertion that there is no special bonus for completion of all subsets, the Examiner respectfully disagrees as Odom discloses two separate awards for the instance when the coverall occurs, thus represents the simultaneous win of such.

Regarding Applicant's argument that scripts are not well known, the Examiner respectfully disagrees. Scripts have been a programming concept known since the early days of programming and are widely used in software. A skilled artisan would be well schooled in



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programming and aware of scripts and would find it obvious to create scripts to control a bonus as it would be a part of the programming software that would have to be validated. The usage of a script would be obvious as an alternate means to execute needed software. It would merely represent a design choice as to how the software controlling the bonus would be executed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cmm

April 14, 2004

  
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